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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,038	12/11/2003	Jonathan T. Zempel	LOT920030019US	8720

45544 7590 03/20/2007
HOFFMAN, WARNICK & D'ALESSANDRO LLC
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EXAMINER

BETIT, JACOB F

ART UNIT	PAPER NUMBER
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2164

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/734,038	ZEMPEL, JONATHAN T.	
	Examiner	Art Unit	
	Jacob F. Betit	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/11/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-8 and 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and tangible result. To perform a physical transformation, the claimed invention must transform an article of physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible result must be either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce the same results given the same initial starting conditions. To be tangible the claimed invention must produce a practical application or real world result. In this case the claims fail to perform a physical transformation because the claims are directed to operating on data. The claims are useful and concrete, but they fail to produce a tangible result because the generated response is never presented to the user or another program or saved to a disk for later use.

3. Claims 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant's invention appears to be directed to a system that is made of only software instructions. Software instructions cannot be fit into one of the four categories of invention and therefore this claim is not statutory. Software instructions are not a

Art Unit: 2164

series of steps or acts and thus is not a process. Software instructions are not a physical article or object and as such is not a machine or manufacture. Software instructions are not a combination of substances and therefor not a composition of matter.

4. Claims 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In paragraph 0020 of the specification the applicant has provided evidence that the applicant intends the medium to include transmission signals as such the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim is not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Redmond et al. (U.S. patent application publication No. 2002/0095401 A1).

As to claim 1, Redmond et al. teaches a method of tracking data, the method comprising:
receiving a request from a client, wherein the request includes a tracked data item (see paragraphs 0040-0041);

Art Unit: 2164

selecting a handler based on the tracked data item (see paragraph 0042);
obtaining response data from a data application based on the tracked data item (see paragraph 0050); and
generating a response based on the response data using the handler (see paragraph 0055-0056).

As to claim 2, Redmond et al. teaches further comprising providing the response to the client (see paragraph 0056).

As to claim 3, Redmond et al. teaches wherein the selecting step is further based on the client (see paragraph 0044).

As to claim 4, Redmond et al. teaches wherein the obtaining step includes:
retrieving a trackable object associated with the tracked data item (see paragraph 0042);
and
providing the trackable object to the data application (see paragraph 0045-0047).

As to claim 5, Redmond et al. teaches wherein the obtaining step includes:
retrieving at least one measurable objective associated with the tracked data item (see paragraph 0035 and paragraph 0040); and
providing the at least one measurable objective to the data application (see paragraph 0040).

As to claim 6, Redmond et al. teaches wherein the generating step includes:
obtaining format data based on a response format (see paragraph 0041); and
formatting the response data using the format data (see paragraph 0043).

As to claim 7, Redmond et al. teaches wherein the format data defines a predefined tracking standard (see paragraph 0042).

As to claim 8, Redmond et al. teaches wherein the generating step includes:
obtaining client data based on the client (see paragraph 0050); and
formatting the response data using the client data (see paragraphs 0050-0052).

As to claim 9, Redmond et al. teaches a method of tracking data, the method comprising:
receiving a request from a client, wherein the request includes a tracked data item (see paragraphs 0040-0041);

selecting a handler based on the tracked data item and the client (see paragraph 0042);
obtaining response data for the tracked data item from a data application (see paragraph 0050);

generating a response based on the response data using the handler (see paragraph 0055);
and

providing the response to the client (see paragraph 0056).

Art Unit: 2164

As to claim 10, see the citations directed to claim 4 above.

As to claim 11, see the citations directed to claim 5 above.

As to claim 12, see the citations directed to claim 6 above.

As to claim 13, see the citations directed to claim 8 above.

As to claim 14, Redmond et al. teaches a system for tracking data, the system comprising:
at least one handler for processing a request that includes a tracked data item (see paragraphs 0040-0042); and

a management system for receiving the request from a client and selecting one of the at least one handlers based on the request (see paragraph 0042);

wherein the selected handler obtains response data for the tracked data item and generates a response based on the response data (see paragraphs 0050 and 0055-0056).

As to claim 15, Redmond et al. teaches further comprising a data application for providing the response data to the selected handler (see paragraph 0056).

As to claim 16, Redmond et al. teaches further comprising a client system for providing client data based on the client (see paragraph 0044).

As to claim 17, Redmond et al. teaches further comprising a format system for providing format data based on a predefined tracking standard (see paragraph 0042).

As to claim 18, Redmond et al. teaches a program product stored on a recordable medium for tracking data, which when executed comprises:

program code for receiving a request from a client, wherein the request includes a tracked data item (see paragraphs 0040-0041);

program code for selecting a handler based on the tracked data item and the client (see paragraph 0042);

program code for obtaining response data for the tracked data item from a data application (see paragraph 0050);

program code for generating a response based on the response data using the handler (see paragraph 0055); and

program code for providing the response to the client (see paragraph 0056).

As to claim 19, Redmond et al. teaches further comprising: program code for retrieving at least one of:

a trackable object and at least one measurable objective associated with the tracked data item (see paragraph 0035); and

program code for providing the at least one of: a trackable object and at least one measurable objective to the data application (see paragraphs 0035 and 0040).

As to claim 20, Redmond et al. teaches further comprising:

program code for obtaining format data based on a response format (see paragraph 0041);

program code for obtaining client data based on the client (see paragraph 0050); and

Art Unit: 2164


program code for formatting the response data using the format data and the client data (see paragraphs 0043 and 0050-0052).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. Betit whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

jfb
13 Mar 2007


SAM RIMELL
PRIMARY EXAMINER